

Remarks/Arguments:

Claims 14, 17-19, 21-22, 37, 40, 42, 45, 47, 49, 51, 53, 55 and 57 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Horton (U.S. Patent No. 4,945,563) in view of Brownstein (U.S. Patent No. 5,671,202). It is respectfully submitted, however, that these claims are patentable over the art of record for the reasons set forth below.

Applicants' invention, as recited by claim 14, includes a feature which is neither disclosed nor suggested by the art of record, namely:

... a provider for receiving signaling from a recipient for said provider to provide said information to said recipient and for providing said information to said recipient responsive to said signaling ...

The above feature is typically referred to in lay person's terms as "on demand programming." Today, this feature is normally implemented by a consumer using their remote control to scroll down a list of movies, finding a desirable movie, pushing the "enter" button on a remote control, and having the movie begin to play. This feature is supported in the original patent (which serves as the basis of the present reissue) at col. 3, lines 30-46. No new matter has been added.

Horton is completely unrelated to "on demand." Horton automatically broadcasts programming. Horton includes technology which permits viewing and/or recording of a program that is broadcast to a recipient. In Horton, the recipient has no ability to control whether or not the program is "on demand." Accordingly, the above feature is neither disclosed nor suggested by Horton.

Brownstein relates to an optical storage disk. Thus, Brownstein is also unrelated to "on demand" programming.

Accordingly, claim 14 is patentable over the art of record. The remaining independent claims set forth above, while not identical to claim 14, include language similar to the language set forth in claim 14. Thus, the above independent claims are patentable over the art of record for reasons similar to those set forth above with regard to claim 14.

Applicants' dependent claims set forth above are patentable over the art of record by virtue of their dependency on allowable independent claims.

Claims 41, 58 and 59 have received separate rejections, but are also patentable over the art of record by virtue of their dependency on allowable independent claims.

Claims 60-65 are newly added. These claims recite the feature of a flag (mode) which is included in signaling received by a provider and which is used by the provider in charging different amounts to the recipient which is receiving information from the provider.

This feature is described in the original patent (which serves as the basis of this reissue application) at col. 3, line 56 et seq. which states:

Subscriber's mode discriminating apparatus 8 outputs the audio/video information either to display terminal 10 such as a CRT or to recording/reproducing apparatus 9 according to the subscriber's request. At the same time, the subscriber's information is transmitted to subscriber's mode recognizing apparatus 3 at the server side through line 11.

Subscriber's mode recognizing apparatus 3 which received an information from the subscriber outputs the information to charging apparatus 4. Charging apparatus 4 is set so that the charging amount is larger when the audio/video information is provided to the subscriber's recording/reproducing apparatus 9 than when provided to the subscriber's display terminal 10 and outputs the charging amount to charge registering apparatus 5 according to the output of subscriber's mode recognizing apparatus 3.

As set forth above, dependent claims 60-65 are describing an embodiment in which billing is being handled on the server side (in the drawings, the left side) of line 11. By contrast, in Horton, the billing is handled on the client's side of the communication pathway between the provider and the recipient. Specifically, as set forth in Horton at col. 3, line 56 et seq.:

Additionally, the decoder 28 would provide billing information to the billing info store and hold circuit 46 which can be transmitted at a convenient to the proper billing authority ... (emphasis added).

In addition to that, although Horton suggests a function to change amount of charges (e.g., Column 2, line 59-63), the claimed structure, "provider receiving signaling which further

contains a flag indicating an output to which the recipient outputs the information...,said provider charging the different amount based on the flag", is not disclosed nor suggested. (see MPEP 2114, the prior art cannot anticipate the claim if there is any structural difference.)

Thus, as the above features are neither disclosed nor suggested by Horton, claims 60-65 are patentable over Horton.

Claims 66-68 are newly added. These claims correspond to the text from the original patent which corresponds to recognizing apparatus 3, charging apparatus 4 and information providing apparatus 2, respectively. The recitation of the features of claims 66-68 on Applicants' server side is completely different than Horton where the billing is handled on the subscriber's side. Because Horton only discloses the structure on the client's side, the claimed "structures", recognizing apparatus and providing apparatus, to performs differentiating amount of charges while providing audio/video information in a "on demand" manner, are not disclosed nor suggested. Thus, at least these claims are also patentable over the art of record.

In view of the amendments and arguments set forth above, the above-identified application is in condition for allowance, which action is respectfully requested.

Respectfully submitted,

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